

REMARKS

Applicant respectfully requests entry of the following amendments and remarks in response to the Office Action mailed April 13, 2009. Applicant respectfully submits that the amendments and remarks contained herein place the instant application in condition for allowance.

Upon entry of the amendments in this response, claims 1 – 21 and 23 are pending. In particular, Applicant amends claims 1. Reconsideration and allowance of the application and presently pending claims are respectfully requested.

I. Examiner Interview

Applicant first wishes to express sincere appreciation for the time that Examiner Hussain spent with Applicant's Attorney, Anthony Bonner, during a telephone discussion on June 22, 2009 regarding the outstanding Office Action. During that conversation, Examiner Hussain and Mr. Bonner discussed potential arguments and amendments with regard to claim 1, in view of *Penner*. The general thrust of the potential principal arguments included a discussion of at least one embodiment of the present application disclosing "prompting the sender to forward the instant message." Thus, Applicant respectfully requests that Examiner Hussain carefully consider this response and the amendments.

II. Rejections Under 35 U.S.C. §112

The Office Action indicates that claims 1, 5, 10, 14, 19, and 20 stand rejected under 35 U.S.C. §112, first paragraph, because there is allegedly no supporting evidence found in the specification for the limitation "indicating, by first recipient, that the IM message originated from sender". Applicant respectfully disagrees with this rejection. More specifically, FIG. 7, block 750 clearly illustrates the disputed claim term. Additionally, page 35, line 10 states "In some

embodiments, the process of FIG. 7 may be performed by the message-handling IM client 115 as shown in FIGS. 1 through 3B.” As block 750 states “indicat[ing] to the 2nd recipient than [the] IM message originated from [the] sender” one of ordinary skill would conclude that the message handling IM client of the first recipient could perform this action. Accordingly, Applicant submits that claims 1, 5, 10, 14, 19, and 20 fulfill all the requirements of 35 U.S.C. §112.

III. Rejections Under 35 U.S.C. §103

A. Claim 1 is Allowable Over *Lee* and *Penner*

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 (“*Lee*”) in view of U.S. Publication Number 7,328,247 (“*Penner*”). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Penner* fails to disclose, teach, or suggest all of the elements of claim 1. More specifically, claim 1 recites:

A communication method comprising:
receiving an instant messaging (IM) message from a sender to a first recipient;
waiting a predefined time interval for an input from the first recipient, the input being responsive to the IM message;
determining whether input from the first recipient is received during the predetermined time interval;

in response to determining that no input from the first recipient is received during the predetermined time interval, prompting the sender to forward the instant message from the first recipient to a second recipient and indicate, by the first recipient, that the IM message originated from the sender, wherein in response to a determination that the recipient is engaged in an IM session with an earlier sender, the sender is queried to join the IM session, and wherein in response determining that the sender desires to join the IM session, the second sender is queried to determine whether to allow the sender to join the IM session.

(Emphasis added).

Applicant respectfully submits that claim 1 is allowable over the cited art for at least the reason that neither *Lee* nor *Penner*, taken alone or in combination, discloses, teaches, or

suggests a "communication method comprising... ***in response to determining that no input from the first recipient is received during the predetermined time interval, prompting the sender to forward the instant message from the first recipient to a second recipient... wherein in response to a determination that the recipient is engaged in an IM session with an earlier sender, the sender is queried to join the IM session, and wherein in response determining that the sender desires to join the IM session, the second sender is queried to determine whether to allow the sender to join the IM session***" as recited in claim 1. More specifically, *Lee* discloses an "agent [that] waits a predetermined amount of time for a response from the invitee to an interactive message sent to the invitee 120. When the time "A" is exceeded 1202, the agent accesses a communication table to determine if another mode of communication has been provided" (page 4, paragraph [0060]). However, *Lee* fails to suggest a "communication method... ***wherein in response to a determination that the recipient is engaged in an IM session with an earlier sender, the sender is queried to join the IM session, and wherein in response determining that the sender desires to join the IM session, the second sender is queried to determine whether to allow the sender to join the IM session***" as recited in claim 1.

Additionally, *Penner* fails to overcome the deficiencies of *Lee*. More specifically, *Penner* discloses an "IM server appliance 210 [that] permits the transfer of an IM message from a first recipient user to a second recipient... such as a transfer from an administrative assistant to an executive" (column 4, line 62). However, this is different than a "communication method... ***wherein in response to a determination that the recipient is engaged in an IM session with an earlier sender, the sender is queried to join the IM session, and wherein in response determining that the sender desires to join the IM session, the second sender is queried to determine whether to allow the sender to join the IM session***" as recited in claim 1.

Further, Applicant submits that a combination of *Lee* and *Penner* is improper for at least the reason that *Penner* teaches away from ***"in response to determining that no input from the first recipient is received during the predetermined time interval, prompting the sender to forward the instant message from the first recipient to a second recipient"*** as recited in claim 1. First, *Penner* discloses "[i]n one embodiment, the transfer is accomplished when the first recipient user receives a message composed by a sender and initiates a message... to the second recipient" (column 5, line 1). As illustrated in this passage, *Penner* discloses that the first recipient receives the message and then forwards that message to the second recipient. Consequently, this teaches away from performing an action ***"in response to determining that no input from the first recipient is received during the predetermined time interval"*** as recited in claim 1. Second, *Penner* discloses "[i]n one embodiment, the sender of the original message of the transfer of the IM message. Preferably, the transfer occurs without requiring the original sender to perform any additional action" (column 5, line 6). As illustrated in this passage, *Penner* discloses that the transfer occurs without the sender doing anything. This however, teaches away from ***"prompting the sender to forward the instant message"*** as recited in claim 1. For at least the reason that *Penner* teaches away from a plurality of elements of claim 1, a combination of *Penner* and *Lee* is improper. For at least these reasons, claim 1 is allowable over the cited art.

B. Claim 5 is Allowable Over Lee and Penner

The Office Action indicates that claim 5 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Publication Number 7,328,247 ("*Penner*"). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Penner* fails to disclose, teach, or suggest all of the elements of claim 5. More specifically, claim 5 recites:

A communication method comprising:
receiving an instant messaging (IM) message from a first sender to a recipient;
determining whether input from the first recipient is received during a predetermined time interval;
in response to determining that no input is received during the predetermined time interval determining whether the first recipient is engaged in an IM chat session with a second sender; and

in response to determining that the first recipient is engaged in an IM chat session with the second sender, prompting the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.

(Emphasis added).

Applicant respectfully submits that claim 5 is allowable over the cited art for at least the reason that neither *Lee* nor *Penner*, taken alone or in combination, discloses a "communication method comprising... ***in response to determining that the first recipient is engaged in an IM chat session with the second sender, prompting the sender to forward the instant message*** from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender" as recited in claim 1. More specifically, a combination of *Lee* and *Penner* is improper for at least the reason that *Penner* teaches away from "***in response to determining that the first recipient is engaged in an IM chat session with the second sender, prompting the sender to forward the instant message***" as recited in claim 5. First, *Penner* discloses "[i]n one embodiment, the transfer is accomplished when the first recipient user receives a message composed by a sender and initiates a message... to the

second recipient" (column 5, line 1). As illustrated in this passage, *Penner* discloses that the first recipient receives the message and then forwards that message to the second recipient. Consequently, this teaches away from performing an action "***in response to determining that the first recipient is engaged in an IM chat session with the second sender***" as recited in claim 5. Second, *Penner* discloses "[I]n one embodiment, the sender of the original message of the transfer of the IM message. Preferably, the transfer occurs without requiring the original sender to perform any additional action" (column 5, line 6). As illustrated in this passage, *Penner* discloses that the transfer occurs without the sender doing anything. This however, teaches away from "***prompting the sender to forward the instant message***" as recited in claim 5. For at least the reason that *Penner* teaches away from a plurality of elements of claim 5, a combination of *Penner* and *Lee* is improper. For at least these reasons, claim 5 is allowable over the cited art.

C. Claim 10 is Allowable Over *Lee* and *Penner*

The Office Action indicates that claim 10 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Publication Number 7,328,247 ("*Penner*"). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Penner* fails to disclose, teach, or suggest all of the elements of claim 10. More specifically, claim 10 recites:

A computer-readable medium encoded with a computer program such that when executed by a computer performs at least the following:

receive an instant messaging (IM) message from a sender to a first recipient;

wait a predefined time interval for an input from the first recipient, the input being responsive to the IM message;

determine whether input from the first recipient is received during the predetermined time interval; and

in response to determining that no input from the first recipient is received during the predetermined time interval, prompt the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.

(Emphasis added).

Applicant respectfully submits that claim 10 is allowable over the cited art for at least the reason that neither *Lee* nor *Penner*, taken alone or in combination, discloses a “computer-readable medium encoded with a computer program such that when executed by a computer performs at least the following... ***in response to determining that no input from the first recipient is received during the predetermined time interval, prompt the sender to forward the instant message*** from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender” as recited in claim 1. More specifically, a combination of *Lee* and *Penner* is improper for at least the reason that *Penner* teaches away from “***in response to determining that no input from the first recipient is received during the predetermined time interval, prompt the sender to forward the instant message***” as recited in claim 10. First, *Penner* discloses “[i]n one embodiment, the transfer is accomplished when the first recipient user receives a message composed by a sender and initiates a message... to the second recipient” (column 5, line 1). As illustrated in this passage, *Penner* discloses that the first recipient receives the message and then forwards that message to the second recipient. Consequently, this teaches away from performing an action “***in response to determining that no input from the first recipient is received during the predetermined time interval***” as recited in claim 10. Second, *Penner* discloses “[i]n one

embodiment, the sender of the original message of the transfer of the IM message. Preferably, the transfer occurs without requiring the original sender to perform any additional action" (column 5, line 6). As illustrated in this passage, *Penner* discloses that the transfer occurs without the sender doing anything. This however, teaches away from "***prompt[ing] the sender to forward the instant message***" as recited in claim 10. For at least the reason that *Penner* teaches away from a plurality of elements of claim 10, a combination of *Penner* and *Lee* is improper. For at least these reasons, claim 10 is allowable over the cited art.

D. Claim 14 is Allowable Over *Lee* and *Penner*

The Office Action indicates that claim 14 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Publication Number 7,328,247 ("*Penner*"). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Penner* fails to disclose, teach, or suggest all of the elements of claim 14. More specifically, claim 14 recites:

A computer-readable medium encoded with a computer program such that when executed by a computer performs at least the following:

receive an instant messaging (IM) message from a first sender to a first recipient;

determine whether input from the first recipient is received during a predetermined time interval;

in response to determining that no input is received during the predetermined time interval, determine whether the first recipient is engaged in an IM chat session with second sender; and

in response to determining that the first recipient is engaged in an IM chat session with the second sender prompt the sender to forward the instant message from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.

(Emphasis added).

Applicant respectfully submits that claim 14 is allowable over the cited art for at least the reason that neither *Lee* nor *Penner*, taken alone or in combination, discloses a "computer-

readable medium encoded with a computer program such that when executed by a computer performs at least the following... ***in response to determining that the first recipient is engaged in an IM chat session with the second sender prompt the sender to forward the instant message*** from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender" as recited in claim 1. More specifically, a combination of *Lee* and *Penner* is improper for at least the reason that *Penner* teaches away from "***in response to determining that the first recipient is engaged in an IM chat session with the second sender prompt the sender to forward the instant message***" as recited in claim 14. First, *Penner* discloses "[i]n one embodiment, the transfer is accomplished when the first recipient user receives a message composed by a sender and initiates a message... to the second recipient" (column 5, line 1). As illustrated in this passage, *Penner* discloses that the first recipient receives the message and then forwards that message to the second recipient. Consequently, this teaches away from performing an action "***in response to determining that the first recipient is engaged in an IM chat session with the second sender***" as recited in claim 14. Second, *Penner* discloses "[i]n one embodiment, the sender of the original message of the transfer of the IM message. Preferably, the transfer occurs without requiring the original sender to perform any additional action" (column 5, line 6). As illustrated in this passage, *Penner* discloses that the transfer occurs without the sender doing anything. This however, teaches away from "***prompt[ing] the sender to forward the instant message***" as recited in claim 14. For at least the reason that *Penner* teaches away from a plurality of elements of claim 14, a combination of *Penner* and *Lee* is improper. For at least these reasons, claim 14 is allowable over the cited art.

E. **Claim 19 is Allowable Over *Lee* and *Penner***

The Office Action indicates that claim 19 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Publication Number 7,328,247 ("*Penner*"). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Penner* fails to disclose, teach, or suggest all of the elements of claim 19. More specifically, claim 19 recites:

A communication system comprising:
means for receiving an instant messaging (IM) message from a sender to a first recipient;
means for determining whether the first recipient has provided an input during a predefined time interval;
means for, in response to determining that the first recipient has not provided an input during the predetermined time interval, determining whether the first recipient is engaged in an IM chat session with another sender;
means for, in response to determining that the first recipient is engaged in an IM chat session with another sender, replying to the IM message; and
means for, ***in response to determining that the first recipient is not engaged in an IM chat session with another user, prompting the sender to forward the instant message*** from the first recipient to a second recipient and indicate, by the first recipient, that the IM message originated from the sender,
wherein all the means are embodied as hardware controlled by software.
(Emphasis added).

Applicant respectfully submits that claim 19 is allowable over the cited art for at least the reason that neither *Lee* nor *Penner*, taken alone or in combination, discloses a "communication system comprising... means for, ***in response to determining that the first recipient is not engaged in an IM chat session with another user, prompting the sender to forward the instant message*** from the first recipient to a second recipient and indicate, by the first recipient, that the IM message originated from the sender" as recited in claim 1. More specifically, a combination of *Lee* and *Penner* is improper for at least the reason that *Penner* teaches away from "***in response to determining that the first recipient is not engaged in an IM chat session with another user, prompting the sender to forward the instant message***" as

recited in claim 19. First, *Penner* discloses "[i]n one embodiment, the transfer is accomplished when the first recipient user receives a message composed by a sender and initiates a message... to the second recipient" (column 5, line 1). As illustrated in this passage, *Penner* discloses that the first recipient receives the message and then forwards that message to the second recipient. Consequently, this teaches away from performing an action "***in response to determining that the first recipient is not engaged in an IM chat session with another user***" as recited in claim 19. Second, *Penner* discloses "[i]n one embodiment, the sender of the original message of the transfer of the IM message. Preferably, the transfer occurs without requiring the original sender to perform any additional action" (column 5, line 6). As illustrated in this passage, *Penner* discloses that the transfer occurs without the sender doing anything. This however, teaches away from "***prompting the sender to forward the instant message***" as recited in claim 19. For at least the reason that *Penner* teaches away from a plurality of elements of claim 19, a combination of *Penner* and *Lee* is improper. For at least these reasons, claim 19 is allowable over the cited art.

F. Claim 20 is Allowable Over *Lee* and *Penner*

The Office Action indicates that claim 20 stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Publication Number 7,328,247 ("*Penner*"). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Penner* fails to disclose, teach, or suggest all of the elements of claim 20. More specifically, claim 20 recites:

A communication system comprising:
a memory component that stores:
instant-messaging (IM) receive logic configured to receive an IM message from a sender to a first recipient;
first determining logic configured to determine whether the first recipient has provided an input during a predefined time interval;
second determining logic configured to, in response to determining that the first recipient has not provided an input during the predetermined time interval, determine whether the first recipient is engaged in an IM chat session with another sender;
reply logic configured to, in response to determining that the first recipient is engaged in an IM chat session with another sender, reply to the IM message; and
prompting logic configured to, ***in response to determining that the first recipient is not engaged in an IM chat session with another sender, prompt the sender to forward the instant message*** from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender.

(Emphasis added).

Applicant respectfully submits that claim 20 is allowable over the cited art for at least the reason that neither *Lee* nor *Penner*, taken alone or in combination, discloses a “communication system comprising... a memory component that stores... prompting logic configured to, ***in response to determining that the first recipient is not engaged in an IM chat session with another sender, prompt the sender to forward the instant message*** from the first recipient to a second recipient and indicating, by the first recipient, that the IM message originated from the sender” as recited in claim 1. More specifically, a combination of *Lee* and *Penner* is improper for at least the reason that *Penner* teaches away from “***in response to determining that the first recipient is not engaged in an IM chat session with another sender, prompt the sender to forward the instant message***” as recited in claim 20. First, *Penner* discloses “[i]n one embodiment, the transfer is accomplished when the first recipient user receives a message composed by a sender and initiates a message... to the second recipient” (column 5, line 1). As illustrated in this passage, *Penner* discloses that the first recipient receives the message and then forwards that message to the second recipient. Consequently, this teaches

away from performing an action "***in response to determining that the first recipient is not engaged in an IM chat session with another sender***" as recited in claim 20. Second, *Penner* discloses "[i]n one embodiment, the sender of the original message of the transfer of the IM message. Preferably, the transfer occurs without requiring the original sender to perform any additional action" (column 5, line 6). As illustrated in this passage, *Penner* discloses that the transfer occurs without the sender doing anything. This however, teaches away from "***prompt[ing] the sender to forward the instant message***" as recited in claim 20. For at least the reason that *Penner* teaches away from a plurality of elements of claim 20, a combination of *Penner* and *Lee* is improper. For at least these reasons, claim 20 is allowable over the cited art.

G. Claims 2, 3, 9, 11, 12, and 18 are Allowable Over *Lee* in view of *Penner*

The Office Action indicates that claims 2, 3, 9, 11, 12, and 18 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") in view of U.S. Publication Number 7,328,247 ("*Penner*"). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Penner* fails to disclose, teach, or suggest all of the elements of claims 2, 3, 9, 11, 12, and 18. More specifically, dependent claims 2 and 3 are allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 1. Dependent claim 9 is allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 5. Dependent claims 11 and 12 are allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 10. Further, dependent claim 18 is allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 14. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

H. Claims 4, 8, 13, and 17 are Allowable Over *Lee*, *Penner*, and *Murphy*

The Office Action indicates that claims 4, 8, 13, and 17 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") and U.S. Publication Number 7,328,247 ("*Penner*") in view of U.S. Publication Number 2007/0274497 ("*Murphy*"). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Penner* and *Murphy* fails to disclose, teach, or suggest all of the elements of claims 4, 8, 13, and 17. More specifically, dependent claim 4 is allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 1. Dependent claim 8 is allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 5. Dependent claim 13 is allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 10. Further, dependent claim 17 is allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 14. Because *Murphy* fails to overcome the deficiencies of *Lee* and *Penner*, claims 4, 8, 13, and 17 are allowable as a matter of law. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

I. Claims 6, 7, 15, and 16 are Allowable Over *Lee*, *Penner*, and *Manabe*

The Office Action indicates that claims 6, 7, 15, and 16 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") and U.S. Publication Number 7,328,247 ("*Penner*") in view of U.S. Patent Number 6,584,494 ("*Manabe*"). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Penner* and *Manabe* fails to disclose, teach, or suggest all of the elements of claims 6, 7, 15, and 16. More specifically, dependent claims 6 and 7 are allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 5.

Further, dependent claims 15 and 16 are allowable for at least the reason that they depend from and include the elements of allowable independent claim 14. Because *Manabe* fails to overcome the deficiencies of *Lee* and *Penner*, claims 6, 7, 15, and 16 are allowable as a matter of law. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

J. Claims 21 and 23 are Allowable Over *Lee*, *Penner*, *Matsumoto*, and *NWG*

The Office Action indicates that claims 21 and 23 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent Number 2003/0233265 ("*Lee*") and U.S. Publication Number 7,328,247 ("*Penner*") in view of U.S. Patent Number 4,639,889 ("*Matsumoto*") and further in view of "XMPP Instant Messaging" by Network Working Group ("*NWG*"). Applicant respectfully traverses this rejection for at least the reason that *Lee* in view of *Penner*, *Matsumoto*, and *NWG* fail to disclose, teach, or suggest all of the elements of claims 21 and 23. More specifically, dependent claims 21 and 23 are allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 20. Because *Matsumoto* and *NWG* fail to overcome the deficiencies of *Lee* and *Penner*, claims 21 and 23 are allowable as a matter of law. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, all objections and/or rejections have been traversed, rendered moot, and/or addressed, and that the now pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and Official Notice, or statements interpreted similarly, should not be considered well-known for the particular and specific reasons that the claimed combinations are too complex to support such conclusions and because the Office Action does not include specific findings predicated on sound technical and scientific reasoning to support such conclusions.

If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

/afb/

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